

REMARKS

This Amendment is made in response to the Office Action dated October 19, 2005. A Request for Extension of Time is enclosed to permit the filing of this Amendment in the third month.

With respect to paragraph 2 of the Office Action, the undersigned submits herewith his Terminal Disclaimer to obviate the double patenting Rejection sent by the Examiner.

With respect to paragraph 3 of the outstanding non-final Office Action, Applicant respectfully traverse and request reconsideration of the rejection of claims 65-99 and 182-247, 249, 250, and 252-334 as being anticipated under 35 U.S.C. §102 by U.S. Patent No. 6,144,388 of Bornstein.

Applicant respectfully asserts that the Examiner has failed to construct a record that satisfies the "sufficient evidence" standard to support his rejection of claims 65-99 and 182-247, 249, 250 and 252-334 as being anticipated under 35 U.S.C. §102(b). In particular, the Examiner has failed to show that the cited Bornstein Patent discloses each element of the rejected claims. The Supreme Court has held that decisions of the U.S. Patent and Trademark Office (USPTO) must meet a new burden of proof. *Dickenson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). The Federal Circuit now reviews findings of fact under the "substantial evidence" standard of the Administrative Procedure Act ("APA") to support a conclusion that a claim at issue is unpatentable. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). To satisfy the "substantial evidence" standard and, therefore, establish a *prima facie* case of anticipation under 35 U.S.C. 102, the USPTO and the Examiner have the initial burden of establishing unpatentability. *In re Mullin*, 481 F.2d

1333, 1336, 179 USPQ 97, 100 (CCPA 1973). The USPTO (whether an Examiner or the Board of Patent Appeals and Interferences ("Board")) must make the necessary findings of fact to construct an administrative record containing evidence to support these findings, accompanied by reasons to support a conclusion of unpatentability. *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000); *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001) ("*Zurko IV*"). After the *Zurko IV* decision, whether a rejection on prior art is sustained by the Federal Circuit depends on whether the USPTO has made an adequate record.

A *prima facie* case requires substantial evidence of all the limitations of the claim being examined. In *In re Kotzab*, the Federal Circuit stated that the mere identification in an applied reference of a particular component that corresponds to a claimed recitation does not satisfy the "substantial evidence" standard. Rather the USPTO is required to make particular findings as to the reasons that a person of ordinary skill in the art, with no knowledge of the claimed invention, would have selected from the applied reference the noted recitations as claimed. To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. §102, a single reference must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986). As will be pointed out below, there are significant recitations of each of the claims 65-99 and 182-333 which are not fairly met by the teachings of the Bornstein Patent as identified in detail below. Thus, it is clear that the *Hybritech* decision of the CAFC requires the Examiner to show that a single reference, i.e. the Bornstein Patent, must teach all of the elements of a claim. The Examiner has established his record by identifying and reproducing those parts of Bornstein upon which he relies to sustain his anticipation rejection of each the

presented claims. In the following, applicant will demonstrate from the Examiner's record, which includes those portions of Bornstein upon which he relies for his anticipation rejections, that Bornstein at a minimum fails to disclose at least one recitation of each claim presented in this application. A review of the Examiner's record indicates that the Examiner has failed to so apply the Bornstein Patent to each recitation of the claims presented in this application.

Applicant respectfully traverses and requests reconsideration of the rejection of Independent Claims 65 and related dependent Claims 66-72. In particular, the Examiner rejects Claim 65 based upon the following disclosure of the Bornstein patent:

Web server **112** has memory storage areas **114** and **116**. Memory storage area **114** (also referred to as the models database) may store information, such as a two-dimensional image of an article of clothing, a three-dimensional model of the article of clothing and the three-dimension image and three-dimensional model of a genetic article of clothing. The two-dimensional model of a generic article of clothing may be a high quality image that would appear in a catalogue, with or without a human model wearing it. The models of the genetic article and articles of clothing may be sorted in the models database in any familiar three-dimensional format well known to those skilled in the art, e.g., 3DS, which is commercially available from Kinetix (a division of Autodesk, Inc.,) San Francisco, Calif, DXF, which is commercially available from Autodesk, San Rafael, Calif., and SAT, which is commercially available from Spatial Technology of Boulder, Colo.

Furthermore, as will be explained later in detail, the three-dimensional sectors and component breakdown scheme associated with each article of clothing selected by the user and the "hidden area" instructions and the component assembly order associated with the generic article of clothing are also stored in memory storage area **114**. In a "hidden area" certain part(s) of the three-dimensional model of article of clothing are hidden, when the article of clothing is superimposed on the image of a human being. In other words, a picture of a person may contain areas that in the "real world" hide parts of the three-dimensional model of article of clothing. By way of example, the head of a person may hide parts of a hat that is placed on the person's head.

Memory storage area **116** (also referred to as the user's picture database) contains several types of information. By way of example, it may contain user details, such as name, login, password and other pertinent details

regarding the user. As another example, it may also have stored therein one or more pictures of the user or another person and the user may have a way to refer to each stored picture by name, index, etc. (Col. 16, Line 55-Col. 17, Line 25).

As shown in Figure 4, Bornstein discloses an internet system 104, which comprises a server 112, a first database 114 that contains two-dimensional images and three-dimensional parameters, a second database 116 containing users information in the form of the users' 2D pictures, its three-dimensional parameters and its hidden area parameters, a web browser 108 and an internet 110 interconnecting the browser 108 to the server 114. Appreciating the Examiner's record with respect to his rejection of claim 65 as reproduced above, Applicant respectfully asserts that the Examiner's record fails to disclose any disclosure of the recitation of "communicating a selecting of the first image and the second image to a server via a network". The Examiner's record relates to the web server 112 and its memory storage areas 114 and 116. In particular, the reproduced passage details the various kinds of data that is stored in the areas 114 and 116, but fails to address the communication of the images via the network or internet 110 to the server 112. In particular, the Examiner's records fails to disclose the selecting of a second image, much less that the selected image is transmitted via the internet 110 to the server 112. The Bornstein patent does not need to select a second image, i.e., an image of the user, much less one of applicant's images of a promotional product. Generally, applicant's system differs significantly from that of Bornstein. In particular, Bornstein selects one of the first images, i.e., images of articles of clothes such as eyeglasses, but does not need nor disclose the selection of one of a plurality of the user's image. In Bornstein's patent, there is no need to select from a plurality of user images, since

each user is capable of supplying its own image and certainly would not desire that its image may potentially be given to other users of this system.

With respect to the rejection of dependent claims 66 – 72 based upon the Bornstein patent, the Examiner relies on the disclosure of “text objects” (Col. 14, Line 39). However, it is respectfully asserted that there is no disclosure in the Examiner’s record of any “logo image.” Therefore, the Examiner has failed to disclose at least one recitation of Claim 67, whereby his anticipation rejection of claim 67 must fail.

Dependent Claim 69 recites that the positioning of the first and second images as presented on the browser “to generate relative positioning information” is disclosed in the following quoted passage of Bornstein:

Next, a step **212** includes manipulating the three-dimensional model of the generic article of clothing on the user’s picture (which was uploaded in step **210**) to arrive at and store the user’s picture three-dimensional clothing parameters mentioned above. Manipulating the generic article of clothing includes translation, rotation, scaling, and warping of the three-dimensional model of the generic article on the image of the person so that the generic article of clothing “fits” onto the image of the person. In other words, the position and size of the generic article of clothing relative to the image of a person is manipulated such that it appears that the person is actually wearing the generic article of clothing. (Col. 19, Lines 46-58).

A careful review of the above quoted passage does not disclose any teaching of generating relative positioning information. The Examiner further relies upon the above quoted passage to disclose the following recitations of Claim 69: 1) “communicating the relative positioning information to the server via the network:” and 2) “automatically generating the composite image of the first and the second image at the server according to the relative positioning

information.” Applicant respectfully asserts that the Bornstein patent does not disclose any of these three recitations, whereby the anticipation rejection based upon Bornstein must fail.

The Examiner rejects dependent Claim 70 reasoning that Bornstein teaches that “the composite image is associated with information in a database, the associated information in the database being communicated together with the composite image from the server to the browser via the network as a photo sample” and that such recitation is disclosed by the following passages from Bornstein:

FIG 1 shows a two dimensional image of a person 100 that may be in a picture, photography or the like. FIG 2A shows a two-dimensional image of an article of clothing, e.g., a pair of eye-glasses 102. (Figs. 1, 4; Col. 1, Lines 19 and 20).

Each picture stored in memory storage area **116** has several parameters (hereinafter referred to as “user’s picture three-dimensional clothing parameters”) associated with it that describe the appropriate, natural position of the generic article of clothing when it is superimposed on the image of the person (in the user’s picture). (Col. 17, lines 27 and 32).

A user picture stored in a floppy disk **122** or another suitable storage device is supplied to stand-alone computer **124**, or alternatively the user picture in a photograph, for example, is scanned by a scanner **120** and supplied to stand-alone **124**. (Col. 17, Lines 55 – 59).

A review of the quoted passages does not disclose the communication of the composite image from the server to the browser via the network as a photo sample. The passage quoted above relates to Figure 5, which discloses a stand-alone computer 124 and not the internet system as disclosed in Figure 4. Thus, the Examiner has failed to disclose at least one of the recitations of Claim 70, whereby the anticipation rejection thereof must fail.

With respect to independent Claim 73 and Claims 74-79 dependent therefrom, applicant respectfully asserts that the Bornstein patent fails to disclose the recitation of

independent Claim 73 for “receiving a first image and a second image at a server from a browser responsive to a user-election of the first image and the second image” for the reasons detailed above with respect to Claim 65.

With respect to independent Claim 80 and Claims 81-84 dependent therefrom, applicant respectfully asserts that the Bornstein patent does not disclose the recitation of “communicating a selection of the first and second image to a server via a network” for the reasons detailed above with respect to Claim 65.

Referring now to independent Claim 85 and Claims 86-89 dependent therefrom, applicant respectfully asserts that the Bornstein patent does not disclose the recitation of “communicating a selection of the first image and the second image to a server via a network” for the reasons detailed above with respect to Claim 65. Further, Bornstein does not disclose the recitation of “presenting a second image for user selection via a second web interface presented on the browser”. It is appreciated that the second image of Bornstein relates to a photograph of the user, and that Bornstein fails to show a user performing “user selection” of his own image. Further, Bornstein does not disclose the recitation of “displaying the composite image via a third Web interface presented on the browser.” Further, Bornstein does not disclose how the web pages are downloaded to the web browser. Unlike Bornstein’s system, applicant discloses, in an illustrative embodiment of his invention, the need for selecting from a plurality of second images or promotional products such an image that would be superimposed on applicant’s first image or logo. By contrast, Bornstein has no need and does not disclose the selecting of one of the plurality of promotional products or images. Further, Bornstein neither discloses nor needs to have a plurality of user images, which could be used by more than one user.

With respect to independent Claim 90 and Claims 91-94 dependent therefrom, applicant respectfully asserts that Bornstein does not disclose “a server to receive a user selection of the first image file and the second image file” for the reasons detailed above with respect to Claim 65.

With respect to independent Claim 95 and Claims 96-99 dependent therefrom, applicant respectfully asserts that Bornstein does not disclose the recitation of “means for communicating a selection of the first image and the second image to a server via a network”, as explained in detail above with respect to Claim 65.

At paragraph 4.8 of the outstanding Office Action, the Examiner states that Bornstein teaches two separate memory storage areas (libraries) for storage of the superimposed data. Though the Examiner does not apply these teachings to a particular claim, Applicant notes that Independent claim 182 recites “first and second libraries.” The Examiner quotes the following passage from Bornstein to establish a teaching of such first and second libraries as recited in Claim 182:

Web server **112** has memory storage areas **114** and **116**. Memory storage area **114** (also referred to as the models database) may store information, such as a two-dimensional image of an article of clothing, a three-dimensional model of the article of clothing and the three-dimensional parameters associated therewith, a two-dimensional image and three-dimensional model of a generic article of clothing. The two-dimensional image of an article of clothing may be a high quality image that would appear in a catalogue, with or without a human model wearing it. (Item 114, Col. 16, Lines 55-64).

Memory storage area **116** (also referred to as the user’s picture database) contains several types of information. By way of example, it may contain user details, such as name, login, password and other pertinent details regarding the user. As another example, it may also have store therein one or more pictures of the user or another person and the user may have a way to refer to each stored picture by name, index, etc.

Each picture stored in memory storage area **116** has several parameters (hereinafter referred to as “user’s picture three-dimensional clothing parameters”) associated with it that describe the appropriate, natural position of the generic article of clothing when it is superimposed on the image of the person (in the user’s picture). By way of example, the user’s picture three-dimensional clothing parameters that are stored in memory storage area **116** include translation, rotation, scaling factor, and warping of the generic article of clothing. In one embodiment of the present invention, the values of these parameters are arrived at after an operator manually adjusts the three-dimensional model of the generic article of clothing on the user’s picture (Item 116, Col. 17, Lines 19-39).

A review of the above quoted passages indicates that Bornstein describes the memory storage area 116 as storing the following data: user name, login, password, one or more pictures of the users and one or more pictures of another person. This passage also indicates that such user data may be accessed by the user employing his name, an index, etc. A clear reading of this disclosure does not teach how the user might browse or otherwise search the memory storage areas 114 and 116 of Bornstein in order to select an image of a particular person. Rather, as specifically disclosed by Bornstein, it would be necessary to know the name or index in order to find access to a particular user.

The above quoted portion of Bornstein used by the Examiner to reject Claim 65 discloses a brief description of the memory storage area 114 as storing information related to an article of clothing and, in particular, of the area 114 as storing “a high quality image that would appear in a catalogue”. Applicant respectfully asserts that such a statement does not indicate that the memory storage areas 114 would themselves be a catalogue or a library. In summary, applicant respectfully asserts that Bornstein does not disclose that the memory storage areas 114 and 116 are a catalogue or a library, whereby access to a number of particular pictures of people or items such as clothing could be readily viewed or browsed as taught by applicant in the subject application.

Applicant respectfully asserts that Claim 182 clearly distinguishes from Bornstein. In particular, Claim 182 is directed to a “method of preparing a server to support a client system to construct a composite image”, as opposed to the network system 104 taught by Bornstein. In contrast to applicant, Bornstein discloses a method of illustrating how a particular article of clothing would appear on a person. On the other hand, applicant constructs first and second libraries for receiving respectively first and second images, which in an illustrative embodiment of this invention may take the form of logos or trademarks and promotional products for receiving such logos. Applicant also establishes a system which permits a user to select from corresponding libraries the promotional products and the marks (or logos) to be superimposed upon the promotional products. In particular, Claim 182 recites the constructing of first and second libraries, wherein first and second sets of images are generated and loaded into their respective libraries.

By contrast, the nature of the Bornstein system does not require a second library, much less that both of the first and second libraries be constructed in a manner that permits each to be loaded with a set of first images and a set of second images. There is no motivation to prepare the Bornstein system by adding a set of user images to a library. In contrast to applicant, Bornstein does not need to construct a set of users and to store them in a library. On the other hand, applicant does need to prepare its first and second libraries by storing respectively a set of promotional products and a set of logos therein. Thus, applicant respectfully asserts that Bornstein does not anticipate all of the recitations of Claims 182. In particular, Bornstein does not need to construct first and second libraries and to respectively generate and load first and second images into the first and second libraries.

With respect to independent Claim 196 and Claims 197-202 dependent therefrom, it is respectfully asserted that Bornstein does not facilitate a user at the clients system to browse or select from a first library at least one of a set of first images and from a second library at least one of said set of second images. It is respectfully asserted that the Examiner's record as reproduced above does not disclose that a user may select at least one of the set of second images or images of promotional products. Thus, Claim 196 is not anticipated by the Bornstein patent for the reasons as described above in further detail with respect to independent Claim 182. Similarly, independent Claim 203 and the related dependent Claims 204-209 also recite facilitating a user to select from first library at least one of said set of first images and from the second library at least one of said set of second images. Applicant respectfully asserts that Bornstein does not teach these recitations of selecting images from first and second libraries for the reasons explained above with respect to Claim 196, and that their rejection as being anticipated must fail.

Similarly, independent Claim 210 and related dependent Claims 211-216 recite facilitating a "user at the client system during the course of said communication session to select from the first library a selected one of said set of first images" and "to select from the second library a selected one of the set of second images." For the reasons detailed above with respect to Claims 182, 196, and 203, Bornstein does not disclose these recitations and therefore the rejection of these claims as being anticipated by Bornstein must fail.

Similarly, independent Claim 217 and related dependent Claims 218-235 recite generating said data representative of said set of second images and loading the set of second images into the second library, and generating data representative of first images and loading

the set of said first images into a first library, which recitations are not taught by Bornstein. Thus, at least one recitation of these claims is not met by Bornstein and their rejection on this reference as being anticipated must fail.

Applicant respectfully asserts that independent Claim 236 and Claims 237-239 dependent therefrom are not anticipated by Bornstein. First, Claim 236 recites a “second image having at least one location affixed thereto” and further “adjusting the relative position of said first image with respect to said second image so that said first image overlies said location of said second image.” Applicant respectfully asserts that Bornstein does not disclose applicant’s “one location” which is affixed to the second image. Rather, as set out in the Examiner’s record with respect to Claim 73, Bornstein does not disclose applicant’s location on a second image and then adjusting the relative position of the first image so that the first image overlies or covers the location of the second image. Rather as noted above, Bornstein does not have a location, and places the image of the article over the image of the person before manipulating the article image until it appears that the person is actually wearing the article of clothing. In particular, applicant respectfully asserts that Bornstein does not teach the recitation of “adjusting the relative position of said first image with respect to said second image so that said first image overlies said location of said second image.” Thus, it is clear that Bornstein does not disclose this recitation and the rejection of Claim 236 based upon Bornstein must fail.

Independent Claim 240 and Claims 241-258 dependent therefrom relate to a “method of preparing a server” including the steps of “construct at least a first and a second web page comprising respectfully a first set of index indicies and a second set of index indicies,” and

displaying “said first and second web pages to respectively facilitate the user to actuate at least one of said first set of index indicies and at least one of said second set of indicies” whereby the user employs the first and second sets of indicies to select at least one of the first images and the second images to comprise the composite image. Applicant has carefully reviewed the Examiner’s record as reproduced above and finds no disclosure in Bornstein of the recited first and second set of index indicies which may be actuated by the user to choose at least one first and one second image to construct the composite image. Thus, Bornstein fails to disclose each recitation of Claim 240 and its rejection as being anticipated must fail.

Independent Claim 259 and Claims 260 and 261 dependent therefrom, recite first and second libraries for storing said set of first and second images respectively, and a “program processor - - to permit the user of the client system to select one of said set of first images and one of said set of said second images” and “responsive to the user selection of one of said set of said second images to access from the second library said selected second image and to the user selection of one of said set of said first images to access from the first library said selected first image.” Applicant respectfully asserts that Bornstein does not disclose first and second libraries but only a single library for storing a plurality of clothing articles. In particular, the Examiner’s record as taken from the parts of Bornstein as noted by the Examiner and reproduced above (Fig. 4, items 114 and 116; Col 16, lines 55 – 64 and Col. 17, lines 19 – 39) indicates that the memory storage area 116 to which access may be gained by name or index to a picture of a user is stored in the memory storage 116. Even so, Bornstein does not disclose that the memory storage area 116 is a library, which is prepared to facilitate the selection of one or more prepared images. Thus, applicant respectfully

asserts that Bornstein does not disclose the recited first and second libraries, and that the rejection of Claim 259 and the related dependent claims must fail.

Applicant's independent Claim 262 and related dependent Claims 263-281 relate to a method of preparing a server to support a user system to provide a composite image and, in particular, recites providing first and second memories, inputting to the server data representative of a plurality of the first images and a plurality of the second images. As reproduced above with respect to the passage noted by the Examiner of Bornstein regarding the memory storage areas 114 and 116 (Fig. 4, items 114 and 116; Col. 16, lines 55 – 64 and Col. 17, lines 19 – 39), the Examiner's record does not disclose that data representative of a plurality of each of the first and second images are inputted to the server. Rather, the above noted portion of the Examiner's record indicates that a user may only access each stored picture of the user by name or an index. Thus, Bornstein does not disclose the noted step of inputting data representing a plurality of the first images and a plurality of the second images and, therefore, the rejection of independent Claim 262 and the related dependent claims must fail.

Independent Claim 282 and the related dependent Claims 283 and 284 relate to a server adapted to support a user system to preview for the user a composite image of a proposed promotional product and a logo product, and recites "generate a plurality of product images and a plurality of logo images." Applicant has carefully reviewed the Examiner's record as reproduced above and concludes that Bornstein fails to disclose the generation of a product image and a logo image, as well as generating a plurality of these images. Applicant

respectfully asserts that Bornstein fails to disclose the quoted recitation and therefore the rejection of independent Claim 282 and the related dependent claims must fail.

Independent Claim 285 relates to a method of operating a server to support a user system to provide a composite image of a promotional product and a logo image. In particular, Claim 285 recites the “assembling said product image and logo image to form said composite image,” whereas Bornstein fails to disclose either product or logo images. Thus, Bornstein does not teach the noted recitation of Claim 285 and its rejection as being anticipated must fail.

Independent Claim 286 and the related dependent claims 287 - 289 similarly recite the construction of a composite image of a product image and a logo image in a fashion similar to that of Claim 285. For the reasons detailed with respect to Claim 285, Claims 286 – 289 are not anticipated by Bornstein.

Independent Claim 290 and its dependent Claims 291-293 also relate to a method of generating a composite image and recite the “communicating a selection of said one logo image and said one product image to a server via a network”. Bornstein does not recite either the processing of a logo image or a product image, or the “communicating a selection of said one logo image and said one product images.” For the reasons explained above with respect to Claim 65, claims 290 – 293 are not anticipated by Bornstein.

Independent Claim 294 and dependent Claims 295-299 relate to a method of generating a composite image and, in particular, recites “receiving a logo image and a product image at a server from a browser responsive to a user-selection of said logo image

and said product image.” First, Bornstein does not disclose the processing of a logo image or a product image. Failing to disclose each of these recitations of Claims 294, Claims 294 – 399 are not anticipated by Bornstein, as explained in detail with respect to Claim 65.

Independent Claim 300 and related dependent Claims 301 - 303 relate to a method of generating a composite image and in particular recites “communicating a user’s selection of said logo image and said product image to a server via a network.” As explained above with respect to Claim 65, Bornstein does not disclose the processing of logo and product images, much less reciting the “communicating a user’s selection of said logo image and said product image to a server via a network,” whereby the rejection of Claim 300 as being anticipated must fail.

Independent Claim 304 and the related dependent Claims 305-307 relate to a method of generating a composite image and reciting the “presenting on the browser a logo image for user selection via a first web interface: and the “presenting on the browser a product image for user selection via a second Web interface.” First, Bornstein does not disclose the processing of logo or product images and, further, fails to disclose the presenting on the browser of both the logo and the product images. As disclosed in a passage taken from Bornstein by the Examiner and described above in detail the memory storage areas 114 and 116, the Examiner’s record clearly teaches that while the article of clothes may be shown on a web site for selection by a user, that the pictures of the users are on the other hand selected only by the name or index of the user. Thus, Bornstein fails to disclose each recitation of Claim 304 and the rejection of Claims 304-307 as being anticipated must fail.

Independent Claim 308, as well as dependent Claims 309-311, relate to an apparatus for generating a composite image and recites “a server to receive a user selection via a network of at least one logo image and at least one product image and to generate said composite image of said one logo image and said one product image.” Applicant respectfully asserts that Bornstein does not disclose the above quoted recitations for the reasons detailed with respect to the rejection of Claim 304 and, therefore, the rejection of Claims 308-311 as being anticipated by Bornstein must fail.

Independent Claim 312 and related dependent Claims 313-315 relate to an apparatus for generating a composite image and recites “means for presenting via a Web interface on a browser logo image” and a product image, and “means for communicating via a network a user selection of the logo image and the product image to a server.” Thus, for the reasons detailed above with respect to Claim 307, the rejection of Claims 312-315 as being anticipated by Bornstein must fail.

Independent claim 316 and the related dependent Claims 317-320 relate to a method of providing information to an electronic site and recites “sending to the electronic site a first information corresponding to said view, wherein said view displays at least one icon including a first logo on a promotional product, wherein said logo is related to a first entity that is associated with the user.” A review of the Examiner’s record clearly indicates that Bornstein does not disclose the display of the “first logo on a first promotional product”. Since Bornstein fails to meet this recitation, the rejection of Claim 316 and the related depended claims as being anticipated must fail.

Independent Claim 321 and the related dependent Claims 322 and 323 relate to a method of providing a digital representation of a promotional product and recites the “combining said electronic representation of said promotional product with information regarding said logo within the electronic file to create a composite digital representation of said promotional product with said logo superimposed thereon.” A review of the Examiner’s record indicates that Bornstein does not disclose the processing of promotional or logo products. Thus, failing to disclose Applicant’s “combining” recitation, the rejection of these Claims 321-323 as being anticipated by Bornstein must fail.

Independent Claim 324 and related dependent Claim 325 relate to a method of obtaining information by a user at an electronic site and recites “sending via the network a first signal to the first entity at a server, wherein said first signal is initiated at a browser by the user selecting at least one first logo from said first set of logos” and “receiving via the network a second information from the first entity wherein said second information is displayed as a second set of promotional products.” Applicant respectfully asserts that Bornstein discloses neither the processing of logos nor the promotional products. Therefore, Bornstein fails to disclose at least two recitations of these claims, whereby the rejection of these Claims 324 and 325 as being anticipated must fail.

Independent Claim 326 and related dependent Claim 327 relate to a method carried out on the internet by facilitating a user to select at least one promotional product from a plurality of promotional products. Claim 326 recites: 1) communicating a plurality of promotional product categories on a first web site; 2) “facilitating the user to select - - one of said - - promotional product categories; 3) “communicating - - to the server - - the selected

one promotional product category;” and 4) for displaying “to the user - - all of a common category” of the promotional products. Applicant respectfully asserts that Bornstein discloses none of the above recitations, whereby the rejection of Claims 326 and 327 as being anticipated must fail.

Independent Claim 328 and related dependent Claims 329 and 330 relate to a method of preparing a server for supporting a client system to provide a composite image including first and second images. Claim 328 recites generating a set of first images from said data representative of said first images, and generating a set of second images from said data representative of said second images and a web page for displaying respectively the first and second images. Applicant respectfully asserts that Bornstein discloses neither of these recitations and, thus, the rejection of these Claims 328-330 as being anticipated by Bornstein must fail.

Independent Claim 331 and related Claims 332 and 333 dependent thereon relate to a server adapted to support a client system to prepare first and second libraries for storing respectively sets of first and second images and thereafter, permitting the client system user to select one of the first and second images from the prepared first and second libraries respectively so that the user may select a second image to be superimposed upon a first selected image. Applicant respectfully asserts that Bornstein does not disclose applicant’s recitation of a programmed processor programmed “to permit the user of the client system to select at least one of said first images and one of said set of second images” from the prepared first library and at least one of said second images from the prepared second library” whereby the selected first image is superimposed upon the selected second image.

Thus, Bornstein fails to disclose at least one recitation of these claims and the anticipation rejection of these Claims 331-333 must fail.

With respect to independent Claim 334, it is respectfully asserted that Bornstein does not permit a user to browse a plurality of the first image and a plurality of second images and is not anticipated by Bornstein for reasons detailed above with respect to claims 182 and 331.

Each of dependent Claims 188, 189, 257 and 268 relate to and recite “normalizing the dimensions of each of said plurality of said second images, and storing said plurality of said normalized images in said second library”. At page 4 of the outstanding Office Action, the Examiner asserts that Bornstein discloses “normalizing of images” by the following quote from Bornstein;

Next, a step **212** includes manipulating the three-dimensional model of the generic article of clothing on the user’s picture (which was uploaded in step **210**) to arrive at and store the user’s picture three-dimensional clothing parameters mentioned above. Manipulating the generic article of clothing includes translation, rotation, scaling, and warping of the three-dimensional model of the generic article on the image of the person so that the generic article of clothing “fits” onto the image of the person. In other words, the position and size of the generic article of clothing relative to the image of a person is manipulated such that it appears that the person is actually wearing the generic article of clothing. (Col. 19, Lines 46-58).

Applicant has carefully reviewed the above cited portion of Bornstein and finds no disclosure of that feature.

Applicant’s Response to the Examiner’s Reply to Applicants Arguments

The Examiner maintains that Col. 16, line 55 – Col 17, line 25 of Bornstein discloses “communicating a selection of the first image and the second image to a server via a network.” Applicant respectfully traverses and requests reconsideration of the rejection of independent claims 65, 80, 85, 95, 259, 282, 290, 300, 304 and 312 as being anticipated

under 35 USC Section 102(e) by the noted portion of Bornstein, which is reproduced above in this Amendment at page 45, line 8 et seq.

Both Applicant's invention and Bornstein's invention relates to the marketing of items, which are represented by two images to help potential purchasers visualize an item before they purchase it.

On the one hand, Applicant's invention creates a first set of promotional products and a second set of logos from which each user may select a product and a logo to be superimposed upon the product. To facilitate the selection of the promotional product and the logo, Applicant develops, as shown in Figure 3C of this application, a first library of first images, i.e., the cup, and a second library of images, i.e., the logos 144'. After the user selects the one cup and the one logo from their respective first and second libraries, the selected logo is super imposed on the selected promotional product. On the other hand, Bornstein's invention identifies or refers to a particular image of the user and potentially others, and creates a library of clothes. After a user identifies its own image, the user selects from a set of articles of clothing a particular article, which is superimposed on the identified user image.

The purposes and goals of Applicant's marketing process are significantly different from those of Bornstein. The Examiner bases his rejection of Applicant's independent claims on the statement in Bornstein that the user stores an image of that user in a memory storage area 116 in a manner, whereby "one or more pictures of the user or another person and the user may have a way to refer to each stored picture by name, index, etc." (see Col. 17, line 20 et seq.) It is implicit in the description of Bornstein's invention that no user may use the image of another user, unless the user of that image can "refer to each stored picture

by name, index, etc.” In other words, the user may identify or infer to its own image and to the images of other by its “name, index, etc.” whereby the image referred to may be used according to Bornstein to provide a model for receiving clothes selected by user. For example, an image user may have a relative and refers a name or index to the relative’s image, whereby an article of clothing can be superimposed on to the relative’s image.

As stated above, Applicant respectfully asserts that Bornstein does not disclose the selection of both first and second images respectively from the first and second image libraries. In particular, Bornstein only teaches that the first images, which represent the articles of clothing, can be selected. Applicant respectfully asserts that Bornstein does not disclose that the second images, i.e., the images of the users can be selected, but rather are identified or “referred” to by a user so that the user or another is referred to a picture stored in the memory storage area 116 by name, index, etc. Further, Bornstein fails to disclose that the user browses images from the first and second libraries and, thereafter, to select respectively first and second images, before communicating the selected first and second images via the network to the server.

Further, Applicant’s invention has significant advantages over the system taught by Bornstein. In particular, Applicant’s process allows for the sharing of his first and second images, e.g. logos and promotional products, with other uses. As shown in Fig. 1, a dynamic graphics server 18c includes both a product template memory 38 for storing a first plurality of first images in the illustrative form of products, and a logo template memory 40 for storing a second plurality of second images, e.g.logos. As shown in Fig. 3B, the user is presented a screen 130b that permits the user to select among a first plurality of first images, e.g. promotional products such as caps, and as shown in Fig. 3E to select among a second

plurality of second images, e.g. logos. According to Applicant's invention, it is contemplated that a user may input its logos into the logo template 38 as shown in Fig. 1, whereby logos are made available to be searched by another user. Thus, Applicant's invention teaches away from the process of Bornstein. According to Bornstein, a user cannot search a plurality of images of another user, unless the user had identified his other user in terms a file name or an index or has referred the other user with the user whose image is that of the user. On the other hand, Applicant does facilitate the user to search a second plurality of second images; in particular, the Applicant has programmed his web server 18a to be able to search the second plurality of images and to find a particular second image. Bornstein does not have such a capability.

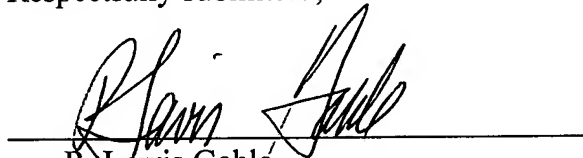
For the reasons asserted above, Applicant respectfully asserts the Independent Claims listed above are clear and not anticipated by Bornstein and, therefore, should now be allowed.

Applicant further traverses and requests reconsideration of the rejection of independent claims 282, 285, 286, 293 ,294, 300, 303, 304 307, 308, 312, 316, 321 and 324 as being anticipated under 35 USC Section 102 over Bornstein . Applicant respectfully asserts that Bornstein does not disclose the use of any logo images. Even so, the Examiner states that the recitation of "text objects" provides the requisite teaching of logos. A review of the Random House Unabridged Dictionary, 2nd Edition indicates that the term "text" broadly defines text in terms of "any of the various forms in which writing exists, "whereas the term "logo" more narrowly co notates a "graphical representation or symbol of a company, name, trade mark, abbreviation etc." Applicant respectfully asserts that the independent claims listed above are clear and not anticipated by Bornstein. Further, Applicant respectfully asserts that dependent

claims 67, 75, 82, 87, 92, 97, 183, 184, 187, 197, 210, 218, 341, 242, 246, 247, 256, 269, 284, 288, 292, 295, 296, 297, 301, 302, 305, 306, 309, 310, 313, 314, 322, 323 and 325 are not disclosed by Bornstein and respectfully request that the Examiner indicate that the subject matter of the listed dependent claims is patentable.

In view of the above discussion, applicant respectfully asserts that each claim now presented in this application is in condition for allowance, which action is respectfully requested. If the Examiner is unable to allow this application, he is requested to call the undersigned to suggest that response whereby this application will be speedily prosecuted to issuance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. Lewis Gable", is written over a horizontal line.

R. Lewis Gable
Reg. No. 22,479
Attorney for Applicant
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, NY 10036
(212) 790-9200